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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,802	06/11/2001	Gad Friedman	LUZZATTO-086	3752

7590

07/16/2003

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EXAMINER

LOVERING, RICHARD D

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/878,802

Applicant(s)

FRIEDMAN ET AL

Examiner

LOVERING

Group Art Unit

1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on JAN. 28 (COF. 1/22) AND APR. 16, 2003.
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-9 AND 11-27 is/are pending in the application.
- Of the above claim(s) 16-25 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-9, 11-13 AND 15 is/are rejected.
- ☒ Claim(s) 14, 26 AND 27 is/are objected to.
- ☒ Claim(s) 1-9 AND 11-27 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 8
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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1. Claims 16-25 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected inventions. Election was made without traverse in Paper No. 6.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-5, 7-9, 11 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over McLaughlin et al. 5,948,323 in view of Fishler et al. 5,072,028 of record. McLaughlin et al. (Example 2 referring to Example 1; and Example 5) discloses aqueous dispersions of flame retardant material such as antimony trioxide and decabromodiphenyl oxide and their preparation by milling to obtain a desired particle size e.g. 0.11 micron or 0.25 micron, noting that in Example 2 the milling is conducted in the presence of Tamol-SN (a sodium salt of condensed naphthalene sulfonate) and Triton CF-10 (an alkylaryl polyether). As to particle size, attention is also directed to McLaughlin et al. (column 2, lines 51-65). While McLaughlin et al. do not disclose pentabromobenzyl acrylate (PBBMA), it would have been obvious to one skilled in the art at the time applicants' invention was made to add the PBBMA of Fishler et al. Example 1 to starting materials in Example 2 of McLaughlin et al. to obtain an aqueous dispersion in which the PBBMA imparts its outstanding flame retardant properties (Fishler et al. - column 2, lines 3-7). The use of a known additive for its known

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function lacks patentable significance. See In re Sussman 554 O.G. 17, 1943 C.D. 518; and In re Kerkhoven, 205 USPQ 1069. As to claims 7-9 herein, the stability stated therein would be inferred from McLaughlin et al. (column 2, lines 40-43). As to claim 11 herein, it would further have been obvious to one skilled in the art at the time applicants' invention was made to incorporate Triton X-100 (McLaughlin et al. - column 5, lines 8-33) in the aqueous dispersions of McLaughlin et al., modified as above by Fishler et al., under the doctrine of In re Crockett et al., 279 F. 2d 274, 126 USPQ 186. Thus, when the prior art of record teaches the use of each of two additives individually; assuming that the two together produce an effect somewhat greater than the sum of their separate effects, the idea of combining them would flow logically from the teaching of the prior art; therefore claims to their joint use are not patentable.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over McLaughlin et al. in view of Fishler et al. as applied to claims 1-5, 7-9, 11 and 12 above, and further in view of Strickland ^E 4,822,524 of record. While the above combination of McLaughlin et al. and Fishler may not disclose the use of xanthan gum, it would further have been obvious to one skilled in the art at the time applicants' invention was made to add the xanthan gum of Strickland to the starting materials in Example 2 of McLaughlin et al., modified as above by Fishler et al., to

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realize the improvement(s) made apparent by Strickland (paragraph bridging columns 2 and 3, esp. column 3, lines 11-13).

5. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over McLaughlin et al. in view of Fishler et al. as applied to claims 1-5, 7-9, 11 and 12 above, and further in view of Gilcrease et al. ^A2,662,061 of record. While the above combination of McLaughlin et al. and Fishler et al. may not disclose the use of a stabilizer or antioxidant, it would further have been obvious to one skilled in the art at the time applicants' invention was made to add e.g. hydroquinone monobenzyl ether of Gilcrease et al. (column 1, lines 7-24, esp. line 23) to the starting materials in Example 2 of McLaughlin et al., modified as above by Fishler et al. The use of a known additive for its known function lacks patentable significance. See the Sussman and Kerkhoven decisions cited above. 7

6. Applicants' arguments filed January 28, 2003 have been fully considered but they are not deemed to be persuasive. Applicants err in contending that McLaughlin et al. exclude PBBMA because they clearly contemplate the inclusion of "other solid chemicals which act as flame retardants or smoke suppressants" (column 1, lines 10-20, esp. lines 19 and 20). Hence, the 103 rejections herein are sound. The Examiner does not rely on Fishler et al. for suspensions, because the primary reference McLaughlin et al. discloses suspensions.

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7. Claim 13 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Claim 13 is indefinite and confusing as to scope and inconsistent in using both "compound" and "synergist". (This ground of rejection can be overcome by changing "synergist" in line 3 to --compound--.)

8. Claims 14, 26 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Claim 13 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. § 112.

10. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record doesn't disclose or fairly suggest the processes of claims 13, 14, 26 and 27 herein.

11. The references listed on the attached Form PTO-1449 are cumulative to the references applied herein, and/or further show the state of the art.

12. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the

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shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lovering whose telephone number is (703) 308-0443. The examiner can normally be reached on Mon.-Fri. from 7:30 A.M. to 4:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 308-2340. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

R. Lovering:cdc
July 15, 2003

Richard D. Lovering
RICHARD D. LOVERING
PRIMARY EXAMINER
GROUP 1700